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Paper No. 3

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**COPY MAILED**

**DEC 3 1 2001**

**OFFICE OF PETITIONS**

In re Application of :  
Montalvo, Escobar, and Willem :  
Application No. 09/988,125 : DECISION REFUSING STATUS  
Filed: 19 November, 2001 : UNDER 37 CFR 1.47(a)  
Attorney Docket No. 6530.0253-00 :

This is in response to the petition filed under 37 CFR 1.47(a) on  
19 November, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of  
this decision to reply, correcting the below-noted deficiencies.  
Any reply should be entitled "Request for Reconsideration of  
Petition Under 37 CFR 1.47(a)," and should only address the  
deficiencies noted below, except that the reply may include an  
oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**

Extensions of time may be obtained in accordance with 37 CFR  
1.136(a).

The above-identified application was filed on 19 November, 2001,  
with a declaration naming Richard Montalvo, Ceasar Escobar, and  
Curt Willem as joint inventors and signed by joint inventor  
Willem on behalf of himself and joint inventors Montalvo and  
Escobar. The present petition was also filed with the  
application.

Petitioners assert that a copy of the application papers was sent via Federal Express to joint inventors Montalvo and Escobar. The application sent to joint inventor Montalvo, assert petitioners was returned as undeliverable. The application sent to joint inventor Escobar was not returned. Petitioners also state that neither inventor could be reached by telephone.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2). In regards to item (1), petitioners have not provided proof that diligent efforts have been made to locate the non-signing inventor.<sup>1</sup> With regard to joint inventor Montalvo, petitioners should submit a copy of the envelope or other correspondence from Federal Express showing that the application was returned as undeliverable.

Additionally, with regards to joint inventor Escobar, a brief Internet search reveals that he may now be residing at a different address in Miami, FL. Petitioners should verify the last known address for joint inventor Escobar and, if joint inventor Escobar is determined to be residing at a different address, send a copy of the application (specification, including claims, drawings, if any, and the declaration) to him at that address. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event that the non-signing inventor refuses to sign the declaration, petitioners must present proof thereof. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the

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<sup>1</sup>MPEP 409.03(d).

refusal in an affidavit or declaration of facts. If the application is returned as undeliverable, petitioners should present a copy of the envelope showing that the application sent to the last known address of the non-signing inventor was returned as undeliverable by the post office.

In regards to item (2), the declaration submitted with the application papers is defective in that it does not specify the mailing address, residence, and citizenship for joint inventors Montalvo and Escobar. In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary. Additionally, the mailing address for joint inventor Willem is incomplete in that it does not include the city, state, and ZIP Code designation. The complete mailing address must be provided in a new oath or declaration. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 is required with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Assistant Commissioner for Patents  
                    Box DAC  
                    Washington, D.C. 20231

By FAX:           (703) 308-6916  
                    Attn: Office of Petitions

By hand:           Crystal Plaza Four, Suite 3C23  
                    2201 S. Clark Place  
                    Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood  
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Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy